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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,316	09/22/2000	Josef Zeevi	16356.549 (DC-02461)	1323

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EXAMINER	
NAHAR, QAMRUN	
ART UNIT	**PAPER NUMBER**
2124	8

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/668,316	ZEEVI ET AL.	
	Examiner	Art Unit	
	Qamrun Nahar	2124	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 July 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This action is in response to the amendment filed on 7/8/03.

2. The objection to the specification is withdrawn in view of applicant's amendment.

3. The objection to claim 16 is withdrawn in view of applicant's amendment.

4. Claims 1, 9 and 16-17 have been amended.

5. Claims 1-22 are pending.

6. Claims 1-22 stand finally rejected under 35 U.S.C. 102(b) as being anticipated by Perugini (U.S. 5,896,494).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Perugini (U.S. 5,896,494).

Per Claim 1 (Amended):

The Perugini patent discloses:

- **a method performed by a computer system** ("The present invention disclosed and claimed herein comprises a diagnostic application for, operation on a computer system ... The diagnostic

application is comprised of a front end module and several tiers of lower level modules." in column 1, lines 57-64)

- **providing a test module** ("At the lowest level are a plurality of diagnostic library modules (DLs) which function to interact with the hardware and software to provide identification and diagnostic information back to the front end." in column 1, line 67 to column 2, lines 1-3)

- **detecting a test module interface associated with the test module, the test module interface being created as an EFI protocol for enabling programs to detect and interact with the test module interface** ("The front end module is responsible for interacting with a user and communicating with the lower level modules to initiate processes ... The front end issues commands to the DLs to load and initialize. In response, the DLs provide device, test and parameter information to a test engine." in column 1, lines 64-67 and column 2, lines 14-21; the front end module is interpreted as a test module interface, where the lower level modules detect and interact with the front end module)

- **calling a function identified by the test module interface to cause a first test configuration of the test module to be created** ("A test definition tool is provided to develop tests without using programming or scripts. The tool presents a graphical test development environment which allows test personnel to easily create tests with a bill of materials. To create a set of tests, the personnel simply drag a device test from an available list to a station profile list. Tests can be enabled/disabled and parameters can be modified. When a file is saved in the test definition tool,

a test definition file is compiled and saved. The test definition file is directly readable by the diagnostic application." in column 2, lines 28-40).

Per Claim 2:

The Perugini patent discloses:

- **detecting a test routine associated with the test module using the first test configuration; and causing the test routine to be executed** (column 13, lines 3-24; column 14, lines 13-15; and column 15, lines 32-34).

Per Claim 3:

The Perugini patent discloses:

- **loading the test module; detecting a device associated with the test module; and in response to detecting the device, creating the test module interface** (column 14, lines 60-67 to column 15, lines 1-5).

Per Claim 4:

The Perugini patent discloses:

- detecting a change associated with the device; and in response to detecting the change, reinstalling the test module interface associated with the test module (column 15, lines 18-34).

Per Claim 5:

The Perugini patent discloses:

- in response to detecting the change, calling the function to cause a second test configuration of the test module to be created (column 13, lines 29-67 to column 14, lines 1-31; and column 15, lines 25-34).

Per Claim 6:

The Perugini patent discloses:

- registering a use of the test module by a program (column 15, lines 6-17).

Per Claim 7:

The Perugini patent discloses:

- unloading the test module; and informing the program of the unloading prior to unloading the test module (column 15, lines 50-58).

Per Claim 8:

The Perugini patent discloses:

- conveying a defer signal from the program to the test module; and in response to the defer signal, canceling the unloading of the test module (column 15, lines 50-58).

Per Claims 9 (Currently Amended), 10-15 & 16 (Currently Amended):

These are system versions of the claimed method discussed above (claims 1-8, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Perugini.

Per Claims 17 (Currently Amended) & 22:

These are another versions of the claimed system discussed above (claims 9 and 14), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Perugini.

Per Claim 18:

The Perugini patent discloses:

- wherein the first function is executable by the processor to cause an entry associated with the first program to be stored in the memory (column 15, lines 6-10).

Per Claim 19:

The Perugini patent discloses:

- wherein the entry includes a first identifier associated with the first program, a second identifier associated with the interface, and a third identifier associated with a second function (column 15, lines 6-17).

Per Claims 20-21:

These are another versions of the claimed system discussed above (claims 15-16, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Perugini.

Response to Arguments

9. Applicant's arguments with respect to claims 1-22 have been fully considered but they are not persuasive.

In the remarks, the applicant argues that:

a) Independent claims 1, 9 and 17 each include:

> "a test module interface being created as an EFI protocol for enabling programs to detect and interact with the test module interface."

The PTO provides in MPEP §2131..."To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection the *Perugini* patent must contain all of the claimed elements of the claims. However, the claimed method and system are not shown or taught in the *Perugini* patent. Therefore, the rejection is unsupported by the art and should be withdrawn.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. Of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the ... claim." *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Examiner's response:

a) Examiner strongly disagrees with applicant's assertion that Perugini fails to disclose the claimed limitations recited in claims 1, 9 and 17. Perugini clearly shows each and every limitation in claims 1, 9 and 17. As recited in amended claims 1, 9 and 17, Perugini further teaches the newly claimed limitation "the test module interface being created as an EFI protocol for enabling programs to detect and interact with the test module interface" (column 1, lines 64-67 and column 2, lines 14-21; the front end module is interpreted as a test module interface, where the lower level modules detect and interact with the front end module). In addition, see the rejection above in paragraph 8 for rejections to claims 1, 9 and 17.

In the remarks, the applicant argues that:

b) Applicant further traverses this rejection on the grounds that these references are defective in establishing a *prima facie!* case of obviousness.

As the PTO recognizes in MPEP § 2142:

> ...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness...

In the present case, the *Perugini* reference does not provide for the claimed test module interface. Thus, the rejection is improper because, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. In this context, 35 U.S.C. §103 provides that:

> A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the *subject matter* as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Because all the limitations of the claims have not been met by the *Perugini* patent, it is impossible to render the :subject matter as a whole obvious. Thus the explicit terms of the statute

have not been met and the Examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

The Federal Circuit has held that a reference did not render the claimed combination *prima facie* obvious in *In re Fine,* 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), because inter alia, the Examiner ignored a material, claimed, temperature limitation which was absent from the reference. In variant form, the Federal Circuit held in *In re Evanega,* 829 F.2d I 110, 4 USPQ2d 1249 (Fed. Cir. 1987), that there was want *of prima facie* obviousness in that:

> The mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that [the requirement is in the reference].

In *Jones v. Hardy,* 727 F.2d 1E>24, 220 USPQ 1021 (Fed. Cir. 1984), the Federal Circuit reversed a district court holding of invalidity of patents and held that:

> The "difference" may have seemed slight (as has often been the case with some of history's great inventions, e.g., the telephone) but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art.

The Federal Circuit has also continually cautioned against myopic focus on the obviousness of the difference between the claimed invention and the prior art rather than on the obviousness vel non of the claimed invention as a whole relative to the prior art as §103 requires. See, e.g., *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986).

Therefore, independent claims 1, 9 and 17, and the claims dependent therefrom are submitted to be allowable.

Examiner's response:

b) Applicant's arguments regarding a *prima facie* case of obviousness/35 U.S.C §103 are moot because the Examiner has relied upon the Perugini reference for 102(b) rejection of claims 1-22, not 35 U.S.C §103.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (703) 305-7699. The examiner can normally be reached on Mondays through Thursdays from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki, can be reached on (703) 305-9662. The fax phone number for the organization where this application or processing is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

QN
September 24, 2003

Todd Ingberg
Primary Examiner
Group 2100